



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/612,087

07/03/2003

Kazaya Katoh

24-007

5849

23400 7590 10/08/2008

POSZ LAW GROUP, PLC
12040 SOUTH LAKES DRIVE
SUITE 101
RESTON, VA 20191

EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

10/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/612,087

Applicant(s)

KATOH ET AL.

Examiner

VICTOR S. CHANG

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-7,9,15-20 and 22-30 is/are pending in the application.
- 4a) Of the above claim(s) 24-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4-7,9,16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 15,17,22 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Introduction

1. Applicants' submissions filed on 8/13/2008 have been entered. Claims 2, 4, 7, 15-17, 19, 20, 22 and 23 have been amended. New claims 24-30 have been entered. Claims 2, 4-7, 9, 15-20, 22-30 are pending. It should be noted that the status identifier "(previously amended)" of claim 20 is incorrect.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In response to the amendments, the grounds of rejection have been updated as set forth below. Rejections not maintained are withdrawn.

Election/Restrictions

4. Newly submitted claims 24-30 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 2, 4-7, 9, 15-20, 22 and 23 are related to new claims 24-30 as subcombination and combination.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-30 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found

allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Rejections Based on Prior Art

5. Claims 2, 7, 9 and 19 are rejected under 35 U.S.C. 102(c) as being anticipated by Moreno [US 20040053044].

Moreno relates to a conformable thick edge adhesive tape. Fig. 3 illustrates that the adhesive tape is a laminate comprising a plurality of adhesive segments 20 (adhesive portions having a predetermined form) and two adhesive sides 18 being provided on the first side of a backing layer 12. The adhesive segments 20 and the thick sides 18 are spaced apart by empty space in between [0020]. The adhesive sides (protective members) 18 are thicker than the adhesive segments 20. The adhesive segments 20 are provided longitudinally in a central portion of the release sheet, and the protective members 18 are provided longitudinally on the release sheet along the edges of the backing layer 12 [0028]. A low adhesion backsize layer (release layer) can be provided on the second side of the backing layer 12 [0027]. The backing layer can be cloth, paper, metal foil, or plastic film [0023]. The adhesive can be virtually any adhesive. The adhesive can include hot melt-coated formulations, transfer-coated formulations, solvent-coated formulations, and latex formulations, as well as laminating, thermally-activated, and

water-activated adhesives and bonding agents. Useful adhesives according to the present invention include all pressure sensitive adhesives [0024].

For claims 2, 7, 9 and 19, since Moreno teaches a conformable adhesive tape, it is interpreted as a flexible material and windable into a roll. It would have been obvious to one of ordinary skill in the art of adhesive tape to wind Moreno's adhesive tape into a conventional roll of tape, motivated by the desire to obtain the convenience for end use. The roll form renders obvious the limitation "the adhesive layer being disposed between the base material and the release sheet so that the release sheet is releasably adherent to the adhesive layer of the adhesive sheet portion" of the claimed invention. Finally, since Moreno's backing layer reads on the base material, regarding the limitation "the base material and the adhesive layer are made of different materials", which is a different material from the adhesive layer.

6. Claims 4-6, 16, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreno [US 20040053044A1], and evidenced by Leander [US 2510120].

The teachings of Moreno are again relied upon as set forth above.

For claim 4, Moreno lacks a teaching that the protective member is "shaped to intrude between the adhesive sheet portions so as to partially overlap the adhesive sheet in a radial direction of a roll when said laminate sheet is wound longitudinally into the roll." However, modifying the distribution of functionally equivalent adhesive pattern is deemed to be obvious to one of ordinary skill in the art, as evidenced by Leander's adhesive sheet having spaced apart adhesive components. Figs. 1 and 2 illustrate that longitudinal distribution of spaced apart adhesive strips is functionally equivalent to circular or curved distribution. The selection of a

Art Unit: 1794

known functionally equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

For claim 5, the edge member can be 2-20 mils [0018].

For claim 6, the amount of overlapping is deemed to be inherent to various suitable adhesive patterns.

For claims 16, 18 and 20, since they are within the scope of rejected claims, they are also rejected for the same reasons as set forth above.

Allowable Subject Matter

7. Claims 15, 17, 22 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. More particularly, Moreno lacks teachings of the limitation "adhesive sheet portions have a planar form that is ring shaped with a central hole-punch portion."

Response to Arguments

8. Applicants argue at Remarks pages 11-12 that

"Moreto fails to teach or suggest, for example, that "the release sheet is releasably adherent to the adhesive layer of the adhesive sheet portions" as recited in the amended independent claims. Because the release sheet is releasably adherent to the adhesive layer of the adhesive sheet portions, the base material and the adhesive layer are peeled off together from the release sheet. The adhesive-side surface of the release sheet has a release property. In Moreno, to the contrary, the adhesive layer is not peeled off from the backing layer because the primer layer increases the adhesion of the adhesive layer to the backing layer. Moreno's adhesive layer is provided on the first side of the backing layer, and a low adhesion backside (LAB) layer is provided on the second side of the backing layer (Moreno, claims 1, 12). This is the opposite of the claimed invention.

However, Moreno's primer layer is optional, and Moreno's LAB reads on the adhesive layer of the claimed invention, as set forth above. The examiner maintains that Moreno anticipates the instant invention as claimed in claims 2, 7, 9 and 19.

Applicants argue at page 12 that

"according to claims 4, 7, 16, 17 and 20, the protective member is shaped to intrude between the adhesive sheet portions so as to partially overlap said adhesive sheet in a radial direction of a roll when said laminate sheet is wound longitudinally into the roll."

However, modifying the distribution of functionally equivalent adhesive pattern is deemed to be obvious to one of ordinary skill in the art, as evidenced by Leander's adhesive sheet having spaced apart adhesive components. Figs. 1 and 2 illustrate that longitudinal distribution of spaced apart adhesive strips is functionally equivalent to circular or curved distribution. The selection of a known functionally equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

Finally, applicants' arguments directed to claims 15, 17 and 23 are moot, because they are indicated as containing allowable subject matter, as set forth above.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/
Primary Examiner, Art Unit 1794